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EXAMINER

RADA, ALEX P

ART UNIT PAPER NUMBER

3712

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/675,291	Applicant(s) MCEACHEN ET AL.	
	Examiner Alex P. Rada	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all of the elements of claims 7, 16, 17, 19-20, 24, 26-27, 28, and 31-32 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

2. Claim 26 is objected to because of the following informalities: The word -- simulated -- should be inserted before the word "fish" in line 4. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 3, parenthesis does not further limit the claims in US practice. The examiner suggests that applicant positively recite the claimed limitation of "a" reader.

Claims 1, 26, 28, and 31 recite a broad range or limitation followed by linking terms (e.g. preferably, maybe, can be, for instance, especially) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection. Furthermore, it is not clear if the particular tag is the same as the tag of the plurality of attachable items. The examiner notes that claim 1 limits to at least one reader to be only one reader. The examiner suggests positively reciting at least one reader is only one reader.

In claim 7, it is not clear if there is only one or a plurality of readers since claim 1 recites the phrase, "at least one reader in the host structure has a plurality of readers".

Claim 13 recites the limitation "at least some of the different outputs" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

In claims 19 and 28, it is no clear as to what are all of the accessories encompassed in the phrase "other accessories".

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 6, 10-15, 17-18 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Au (US Pub. 2003/0138766).

6. Au discloses the following:

A host structure (item 10 of figure 1), a plurality of attachable items which can be selectively attached to the host structure (item 50 of figure 1 and paragraph 0030), and an identification device (items 12 and 16 of figure 1), wherein the identification device comprises at least one reader (within item 16 of figures 2 and 4) and a plurality of tags which (paragraph 0030), when read by the reader(s), provide identification information particular to that tag (paragraph 0034), wherein the reader(s) is(are) housed by the host structure (within items 12 and 16 of figure 1) and the tags are each housed by

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one of the plurality of attachable items (within item 50 of figures 2 and 4), wherein the reader(s) reads the identification information from a particular tag when the corresponding attachable item is attached to the host structure, and wherein a different output is generated depending upon which attachable item has been identified by the reader (paragraph 0034) as recited in claim 1.

The host structure houses only one reader and wherein only one of the attachable items is attachable to the host structure at a time (figure 1) as recited in claim 6.

The output is audio (item 19 in paragraph 0027) as recited in claim 10.

The output is visual (item 19 in paragraph 0027) as recited in claim 11.

The visual output occurs on the attachable item (item 19 in paragraph 0027) as recited in claim 12.

At least some of the different outputs occur on at least one of the attachable items (item 19 in paragraph 0027) as recited in claim 13.

The attachable items are of different colors and the different outputs correspond to these different colors (paragraph 0030) as recited in claim 14.

The attachable items have different numerals printed thereon and wherein the different outputs correspond to these different numerals (paragraph 0030) as recited in claim 15.

The host structure resembles a fishing rod (figure 1) as recited in claim 17.

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The attachable items resemble fish, aquatic animals and/or sea creatures (figure 1 and paragraph 30) as recited in claim 18.

Connectors for connecting the attachment items to the host structure (figures 2 and 4) as recited in claim 22.

The connectors comprise a magnetic connecting arrangement between the host structure and the attachment items (item 36 of figure 2 and paragraph 0029) as recited in claim 23.

The connectors comprise a hook- and-loop fastening arrangement between the host structure and the attachment items (figures 1-2) as recited in claim 24.

The attachment items are fitted around the host structure (figures 2 and 4) as recited in claim 25.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Au (US Pub. 2003/0138766) as applied to claim 1 above and in view of Soto et al. (US Pub. 2003/0171063) and Kawai et al. (US 4,869,701).

9. Au discloses the claimed invention as discussed above except for the following:

The identification device is a radio frequency identification device as recited in claim 2.

The reader(s) broadcast a radio frequency activation signal, which is received by one of the tags when the corresponding attachable item is attached, and wherein the tag is powered to transmit identification information to the reader as recited in claim 3.

The identification device is a bar code identification device as recited in claim 4.

Each tag comprises a bar code printed on the attachable item as recited in claim 5.

The host structure houses a plurality of readers and wherein a plurality of the attachable items can be attached to the host structure at the same time as recited in claim 7.

The identification device generates an output when all of the attachable items are attached to the host structure as recited in claim 8.

Soto et al teaches the following:

The identification device is a radio frequency identification device (paragraph 0007) as recited in claim 2.

By having a radio frequency reader and tags, one of ordinary skill in the art would provide an alternative interactive audio and/or visual output to encourage educational enrichment and increase better play experience.

Kawai et al teaches the following:



The reader(s) broadcast a activation signal, which is received by one of the tags when the corresponding attachable item is attached, and wherein the tag is powered to transmit identification information to the reader, wherein the waveform memories (42 and 43) are used to store a series of sampling data representative of sound which are activated when the identification code generators of elements in figures 1 and 2 are correctly attached or an error signal if the incorrect element is attached to the barrel member in col. 6, lines 42-52 to be the reader(s) broadcast a activation signal, which is received by one of the tags when the corresponding attachable item is attached, and wherein the tag is powered to transmit identification information to the reader as recited in claim 3.

The host structure houses a plurality of readers and wherein a plurality of the attachable items can be attached to the host structure at the same time (figures 1 and 4) as recited in claim 7.

The identification device generates an output when all of the attachable items are attached to the host structure (col. 7, lines 24-30) as recited in claim 8.

At the time the invention was made, it would have been an obvious design choice to a person of ordinary skill in the art to include at least one reader and tags comprising of a bar code identification device as recited in claim 4-5 because similar technology known in the art like magnetic strip or RFID to provide the same purpose as reading coded signals to produce different audio and/or visual type of outputs. One of ordinary skill in the

art, furthermore, would have expected Applicant's invention to perform equally well with the identification device disclosed in Au and Kawai because having any type of identification device would provide the same outcome of identifying objects for amusement or educational purposes.

By having an activation signal received by one of the tags when the corresponding item is attached, one of ordinary skill in the art would provide audible indication that the toy component is correctly or incorrectly attached.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Au to include a radio frequency identification device and the reader(s) broadcast a radio frequency activation signal, which is received by one of the tags when the corresponding attachable item is attached, and wherein the tag is powered to transmit identification information to the reader, a barcode reader, a plurality of readers and wherein a plurality of the attachable items can be attached to the host structure at the same time and the identification device generates an output when all of the attachable items are attached to the host structure as taught by Soto et al and Kawai. By having a radio frequency reader and tags, one of ordinary skill in the art would provide an alternative interactive audio and/or visual output to encourage educational enrichment and increase better play experience and an audible indication that the toy component is correctly or incorrectly attached.

10. Claims 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Au (US Pub. 2003/0138766) as applied to claims 1 and 15 above and further in view of Lee et al. (US 4,968,255).

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11. Au discloses the claimed invention as discussed above except for the identification device. Au has different modes of operation and wherein the outputs change depending upon the selected mode of operation and the outputs corresponding to addition or subtraction of these numerals.

Lee et al teaches in col. 4, line 51 – col. 7, line 21 six different modes of operation and wherein the outputs change depending upon the selected mode of operation.

By having different mode selection, one of ordinary skill in the art would provide an electronic instructional apparatus that helps develop skills of a child when the device is being manipulated.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Au to include different modes of operation and wherein the outputs change depending upon the selected mode of operation as taught by Lee et al to provide an electronic instructional apparatus that helps develop skills of a child when the device is being manipulated.

12. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Au (US Pub. 2003/0138766) as applied to claim 1 above and further in view of Silva (US 6,257,948).

13. Au discloses the claimed invention as discussed above except for the following:

The host structure resembles a personality-void head and the attachable items resemble hats, masks, wigs, and other accessories to provide a certain personality of the head as recited in claim 19.

The host structure resembles a torso and the attachable items resemble body parts attachable to the torso as recited in claim 20.

The identification device generates an output when all of the attachable items are attached to the host structure as recited in claim 21.

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Silva teaches the following:

The host structure resembles a personality-void head (10) and the attachable items resemble hats, masks, wigs, and other accessories to provide a certain personality of the head (figures 1-3) as recited in claim 19.

The host structure resembles a torso and the attachable items resemble body parts (items 20 and 22) attachable to the torso (figure 1) as recited in claim 20.

The identification device generates an output when all of the attachable items are attached to the host structure (item 576 of figure 13) as recited in claim 21.

By having a host structure resemble a personality-void head, one of ordinary skill in the art would provide an alternative embodiment to maintain the interest of a child when playing with the toy.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Au to include a host structure resembles a personality-void head and the attachable items resemble hats, masks, wigs, and other accessories to provide a certain personality of the head, the host structure resembles a torso and the attachable items resemble body parts attachable to the torso and the identification device generates an output when all of the attachable items are attached to the host structure as taught by Silva to provide an alternative embodiment to maintain the interest of a child when playing with the toy.

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14. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Au (US Pub. 2003/0138766) in view of Soto et al. (US Pub. 2003/0171063).

15. Au discloses the following:

A host structure which resembles a fishing rod (item 10 of figure 1), a reader housed by the host structure (item 16 of figure 1) and positioned at an attachment location corresponding to where a fish would be caught by a fishing rod (figure 1), a plurality of attachable items which can be selectively attached (paragraph 0030), one at a time (figure 1), to the host structure at the attachment location (figures 1 and 2), a plurality of tags each housed by one of the plurality of attachable items (within item 50 of figure 1) and, when respectively read by the reader, providing identification information particular to that attachment item (paragraph 0034), and magnetic connectors (item 36 of figure 1) for connecting the attachable items to the attachment location (paragraph 0034), wherein the reader reads the identification information from a particular tag when the corresponding attachable item is attached to the host structure (paragraph 0034 and figure 6), and wherein a different output is generated depending upon which attachable item has been identified by the reader (paragraph 0034) as recited in claim 26.

The attachable items resemble fish, aquatic animals, and/or sea creatures (paragraph 0030) as recited in claim 27.

Au does not expressly disclose a radio frequency reader and tags as recited in claim 26-27.

Soto et al teaches a scanting toy having a radio frequency reader (item 98 figure 1) and tags (figures 4A-4B) as recited in claims 26-27.

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By having a radio frequency reader and tags, one of ordinary skill in the art would provide an alternative interactive audio and/or visual output to encourage educational enrichment and increase better play experience.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify AU to include a radio frequency reader and tags as taught by Soto et al to provide an alternative interactive audio and/or visual output to encourage educational enrichment and increase better play experience.

16. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silva (US 6,257,948) in view of Soto et al. (US Pub. 2003/0171063) and Kawai et al (US 4,869,701).

17. Silva discloses the following:

A host structure which (10) comprises a substantially spherical object with facial expressions thereon (figure 1), a reader housed by the host structure and positioned in an upper portion of the spherical object, wherein the encoders 192-206 to be comparable to the a reader housed by the host structure and positioned in an upper portion of the spherical object, a plurality of attachable items which resemble hats, masks, wigs and other accessories and which can be selectively attached to the host structure by fitting them around the upper portion of the substantially spherical object (figures 1-2), and a plurality of tags each housed by one of the plurality of attachable items, when respectively read by one of the readers, provides identification information particular to that attachment item, and wherein the reader reads the identification information from a particular tag when the corresponding attachable item is attached to the host structure, wherein the

plurality of attachable appendages having a key portion 70-76 including encoded portions 78-84 having contours defined by raised portions 86-108 and when inserted into the different openings the encoders 192-206 provide a response to the inserted item to be a plurality of tags each housed by one of the plurality of attachable items, when respectively read by one of the readers, provides identification information particular to that attachment item, and wherein the reader reads the identification information from a particular tag when the corresponding attachable item is attached to the host structure, and a different output is generated depending upon which attachable item has been identified by the reader (figure 13) as recited in claim 28.

At least some of the different outputs are provided through at least some of the attachment items (figure 13) as recited in claim 29.

Silva does not expressly disclose the following:

A radio frequency reader and tags as recited in claim 28

The outputs provided through the attachment items comprise lights, which are turned on when the attachment item is identified by the reader as recited in claim 30.

Soto et al teaches a scanting toy having a radio frequency reader (item 98 figure 1) and tags (figures 4A-4B) as recited in claims 26-27. By having a radio frequency reader and tags, one of ordinary skill in the art would provide an alternative interactive audio and/or visual output to encourage educational enrichment and increase better play experience.

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Kawai teaches an educational toy having components member with predetermined shapes, a detecting device for detecting the assembly state of the toy component and sound or light generating device for emitting the correct assembly of the toy to be the outputs provided through the attachment items comprise lights, which are turned on when the attachment item is identified by the reader (col. 8, lines 35-40) as recited in claim 30. By having lights to indicate the attachment of an item, one of ordinary skill in the art would provide a visual indication that an item is securely attached.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Au to include a radio frequency and tags and an output of an attachment comprising of lights which are turned on when the attachment item is identified by the reader as taught by Soto et al and Kawai to provide an alternative interactive audio and/or visual output to encourage educational enrichment and increase better play experience and a visual indication that an item is securely attached.

18. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai et al (US 4,869,701) in view of Soto et al. (US Pub. 2003/0171063).

19. Kawai disclose the following:

A host structure which resembles a torso (items 11 and 21 of figures 1 and 3), a plurality of readers (within item 11 and 21 of figures 1 and 3) housed by the host structure at different attachment locations corresponding to missing body parts (figures 1 and 3), a plurality of attachable items which resemble the missing body parts (item 12-16 and 22-36 of figures 1 and 3) and which can be selectively attached to the host structure at the different attachment locations (figures 1 and 3), a plurality of tags each housed by one



of the plurality of attachable items (items 12A-16A of figure 4) and, when respectively read by one of the readers, providing identification information particular to that attachment item, and wherein each of the readers read the identification information from a particular tag when the corresponding attachable item is attached to the adjacent attachment location, and wherein a different output is generated depending upon which attachable item has been identified by the reader (col. 8, lines 18-40) as recited in claim 31.

The host structure resembles a teddy-bear torso and the attachment items resemble teddy-bear body parts, wherein Kawai is capable of having different shapes such as airplanes, a train and specific animals to be the host structure resembles a teddy-bear torso and the attachment items resemble teddy-bear body parts (col. 7, lines 39-47) as recited in claim 32.

Kawai does not expressly disclose a radio frequency reader and tags as recited in claim 31.

Soto et al teaches a scanting toy having a radio frequency reader (item 98 figure 1) and tags (figures 4A-4B) as recited in claim 31. By having a radio frequency reader and tags, one of ordinary skill in the art would provide an alternative interactive audio and/or visual output to encourage educational enrichment and increase better play experience.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Kawai to include a radio frequency and tags as taught by Soto et al to provide an alternative interactive audio and/or visual output to encourage educational enrichment and increase better play experience.

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***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Beck (US Pub. 2004/0229696 & US Pub. 2004/0214642) and Cusolito all disclose different types of objection recognition type toys.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Am*  
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**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**